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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,359	01/28/2004	Hiroaki Kishioka	Q79404	1537

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EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/765,359	Applicant(s) KISHIOKA ET AL.	
	Examiner Daniel Zirker	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/28/04</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1771

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for in general most of the claimed limitations, does not reasonably provide enablement for two limitations that are commented on most particularly on page 51 of the disclosure. More particularly, the limitations of adhesive article thickness and optical isotropy are here set forth as being apparently critical to the claimed invention. Yet it is noted that the thickness limitation is nowhere claimed and, more seriously, the specification does not appear to teach in an enabling manner how optical isotropy for the claimed genus of adhesive articles is attained. Applicants state that the first two Examples attain desired optical characteristics, but just what are the elements found in these two examples that are not present in the remaining examples and Comparative Examples found in the specification is not at all clear to the Examiner. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention..

Art Unit: 1771

4. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/0098352A1 to Kishioka, one of the coinventors of the present application, taken either individually, or in view of JP Abstract 07-105781. Kishioka discloses (note particularly the Abstract, Paragraphs 0001, 0005, 0039, 0040, 0052, 0053, 0061, 0062, 0064, 0065,) a genus of applicants' preferred acrylic based pressure sensitive adhesives of the requisite thickness and believed desired optical characteristics which can be used to form double sided adhesive optical tapes which, although they generally possess a suitable film substrate or carrier, are taught (paragraphs 0062, 0065) as existing without the presence of the substrate in certain embodiments. Note also that applicants' independent claim requires only the presence of the double sided adhesive sheet, not the adhered to elements as well. While it appears that typically the adhesive layers without substrates are only a single adhesive layer, the reference appears in these two referred to sections to imply that double sided adhesive layers without a substrate might be desirable. In any event, alternatively JP'781 teaches the use of adhesive tapes 7 which may be formed without a substrate in environments such as applicants contemplate, and accordingly the Examiner believes that this reference would supply the necessary motivation to modify the adhesive sheets of Kishioka to not utilize a substrate and thereby form, or clearly render obvious, the claimed genus of tapes and also the adhered to touch panel-provided display device set forth in dependent claim 6. Other parameters, such as the number of adhesive layers (claim 2) and the peel strengths of the adhesive layers (claim 4) are each believed to be, if not

Art Unit: 1771

expressly or inherently disclosed, obvious modifications to one of ordinary skill, in the absence of unexpected results. .

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also the PGPubs to Okochi et al and Sugawara et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Zirker
Primary Examiner
Art Unit 1771

A handwritten signature in black ink that reads "Daniel Zirker". The signature is written in a cursive, flowing style.